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10/020,802

12/07/2001

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EXAMINER

WILLIAMS, KIMBERLY A

ART UNIT

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2625

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/020,802

Applicant(s)

FREDLUND ET AL.

Examiner

Kimberly A. Williams

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3,4,7,8,10,12,17 and 22-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7,17,24,26 and 27 is/are allowed.
- 6) ☒ Claim(s) 3,4,8,10,12,22,25 and 28 is/are rejected.
- 7) ☒ Claim(s) 23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

**Applicants please note that a new examiner has been assigned to this application.**

1. This action is in response to an appeal brief filed 5/9/07. Claims 3,4,7,8,10,12,17 and 22-28 are pending.

#### ***Response to Arguments***

2. Applicant's arguments, see the appeal brief, p. 4, last para, p. 5, 4<sup>th</sup> para, p. 9, 4<sup>th</sup> para, p. 11, 2<sup>nd</sup> para, p. 13, paras 2 and 3 and p. 14, next to last para, filed 5/9/07, with respect to claims 4 & 23, 27, 3 & 22, 7, 8 & 25, and 10 & 12, respectively have been fully considered and are persuasive. The final rejection of claims 3,4,7,8,10,12,22-25,27 and 28 has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Murata, Reeley and Fredlund as explained in further detail below. Regarding claim 28, Han (applied by previous examiner) teaches a fourth embodiment, which is adapted for image editing, which reads on the modification input.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 3,8,22,25 and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Murata (US 2001/0052994).

Regarding **claim 3**, Murata teaches a portable imaging system (fig. 16) transportable by a user for scanning an image for later production of an image product, comprising: (a) a first and second member movable between an open and closed position (lid and scanner body); (b) a scanning area disposed in either the first or second member and accessible when the system is in the open position for receiving and scanning the image to produce a digital image; (c) a memory for storing the digital image (page and buffer memories such as shown in fig. 2); (d) a communication port adapted to transmit the digital image from the portable imaging system over a communications network to a device for later production of the image product from the digital image (LAN controller such as shown in fig. 2); and an image input device (slots 89 as shown in fig. 1 or 123, fig. 16) having an opening for receiving a removable digital image media (such as memory card 124) to enable digital image input at said opening from said digital image media to the memory of the portable imaging system (an original image is scanned into the scanner in accordance with a scan job command file and is stored on the memory card (note para 70); the user inserts then inserts the memory card, which contains a print job command file and the image data file and the image is transferred from the slot to the printer via the page and buffer memories such as shown in fig. 2; note paras 63,96,97,125,126).

Regarding **claim 8**, in addition to the like teaching of claim 3 above, Murata teaches a software for tracking information associated with the digital image wherein the information is an image name or a scanning date (CPU 85, such as shown in fig. 2, controls the entire device, para 63, stores the image data into the memory card with an image data file name, para 125, and refers to the image data file name in the print job command file to read the image data file from the memory card, para 97).

Regarding **claims 22 and 25**, since Murata teaches that the image data is stored on the memory card, the memory card reads on the second, redundant, memory to provide backup storage of the digital image to ensure the digital image is not lost.

Regarding **claim 28**, in addition to the like teaching of claim 3 above, Murata teaches a modification input for zooming, cropping, or rotating the digital image before or after storage in memory (an image processor such as shown in figs. 14 and 15 comprises a zooming ckt. 133 and a trimming ckt. 134).

5. Claims 3,4 and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Reece (US 6567190).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding **claim 3**, Reele teaches a portable imaging system (fig. 2) transportable by a user for scanning an image for later production of an image product, comprising: (a) a first and second member movable between an open and closed position (flip cover 225 and scanner body 110); (b) a scanning area disposed in either the first or second member and accessible when the system is in the open position for receiving and scanning the image to produce a digital image; (c) a memory for storing the digital image (RAM 126); (d) a communication port adapted to transmit the digital image from the portable imaging system over a communications network to a device for later production of the image product from the digital image (additional items can be added so that the user can view images downloaded from the internet; col. 4, lines 37-44); and an image input device (127) having an opening for receiving a removable digital image media to enable digital image input at said opening from said digital image media to the memory of the portable imaging system (col. 4, lines 33-37).

Regarding **claim 4**, in addition to the like teaching of claim 3 above, Reele teaches an input device adapted to collect information associated with the digital image, and wherein the input device is a keyboard or a touchscreen display (col. 3, lines 45-57).

Regarding **claim 28**, in addition to the like teaching of claim 3 above, Reele teaches a modification input for zooming, cropping, or rotating the digital image before or after storage in memory (images are displayed for editing; col. 3, lines 45-50, col. 4, lines 18-25).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murata in view of Fredlund et al. (US 5666215).

Regarding **claim 10**, Murata teaches a portable imaging system (fig. 16) transportable by a user for scanning an image for later production of an image product, comprising: (a) a first and second member movable between an open and closed position (lid and scanner body); (b) a scanning area disposed in either the first or second member and accessible when the system is in the open position for receiving and scanning the image to produce a digital image; (c) a memory for storing the digital image (page and buffer memories such as shown in fig. 2); and (d) a communication port adapted to transmit the digital image from the portable imaging system over a communications network to a device for later production of the image product from the digital image (LAN controller such as shown in fig. 2).

Although Murata teaches an image input device (slots 89 as shown in fig. 1 or 123, fig. 16) having an opening for receiving a removable digital image media (such as memory card 124) to enable digital image input at said opening from said digital image media to the memory of the portable imaging system (an original image is scanned into the scanner in accordance with a scan job command file and is stored on the memory

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card (note para 70), Murata fails to specifically disclose an audio input device for receiving audio information relating to the scanned digital image.

Fredlund teaches a system and method for the selection and ordering of photographic images for printing and other image related services wherein the customer can also send a sound file representing sampled audio to the processing lab to add sound producing capability to the image related product. The order information can be returned to the photo-processing lab 14 by sending the information on a computer readable diskette 100 (col. 7, lines 1-17).

Murata could be modified to include a sound file with the scan job command file that is stored on the memory card. This modification would have been obvious to one of ordinary skill in the art at the time of the invention since Murata teaches a removable storage medium, used for offline printing, that could be used in the system of Fredlund to produce an image bearing product having sound associated with it.

Regarding **claim 12**, since Murata teaches that the image data is stored on the memory card, the memory card reads on the second, redundant, memory to provide backup storage of the digital image to ensure the digital image is not lost.



8. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Han (US 6608707) in view of well known prior art (MPEP 2144.03).

Regarding **claim 28**, Han teaches a portable imaging system (fig. 6) transportable by a user for scanning an image for later production of an image product, comprising: (a) a first and second member movable between an open and closed position (lid and scanner body, fig. 8); (b) a scanning area disposed in either the first or second member and accessible when the system is in the open position for receiving and scanning the image to produce a digital image; (c) a memory for storing the digital image (col. 7, lines 37-50); (d) a communication port adapted to transmit the digital image from the portable imaging system over a communications network to a device for later production of the image product from the digital image (fig. 9); and a modification input for zooming, cropping, or rotating the digital image before or after storage in memory (the fourth embodiment teaches a flatbed scanner adapted to control conventional scanning, editing, input and output functions, col. 5, lines 55-60 and col. 8, lines 24-27). Although Han does not specifically disclose the editing functions, the examiner takes official notice that it is well known in the art for a scanner to contain a keyboard and/or display in order to edit a scanned image. This modification would have been obvious to one of ordinary skill in the art at the time of the invention since it is desired of Han's fourth embodiment to have a stand alone scanner ready to scan, copy, save and perform its other functions.

***Allowable Subject Matter***

9. Claim 23 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. Claims 7,17,24,26 and 27 are allowed.

11. The following is an examiner's statement of reasons for allowance: the prior art of record does not teach the claimed subject matter of claims 7,24 and 27. Therefore claims 7,24 and 27 are allowable for the reasons pointed out by Applicant's remarks (see appeal brief, p. 11, 2<sup>nd</sup> para and p. 5, 4<sup>th</sup> para). It follows that claim 24 is then inherently allowable for depending on an allowable base claim. Claims 17 and 26 are allowed for reasons given by the examiner in the office action dated 6/5/06.


***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly A. Williams whose telephone number is (571) 272-7471. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Kimberly A Williams  
Primary Examiner  
Art Unit 2625

KAW  
August 27, 2007